



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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IFW

Appellant: Robert R. Turvey)

Serial No.: 09/872,378)

Filed: June 1, 2001)

For: METHOD AND APPARATUS FOR
PRODUCING PLASTIC BAGS)

Group Art Unit: 3721)

Examiner: John Roger Paradiso)

Docket No.: J-2904)

Customer No.: 29471)

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July 26, 2004

Erin J. Fox
Erin J. Fox
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Mail Stop Appeal Briefs-Patent
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith are three (3) copies of Appellant Appeal Brief with respect to the Appeal taken to the Board of Patent Appeals and Interferences in the above-identified application.

Also enclosed is our check in the amount of \$330.00, the fee for filing the Appeal Brief. The Commissioner is hereby authorized to charge any fees that may be required under 37 CFR 1.17(f) or any deficiency therein to Deposit Account No. 50-1903. A copy of this transmittal is attached. Any overpayment in fees should be refunded to McCracken & Frank LLP at the address below.

Respectfully submitted,

McCracken & Frank LLP

July 26, 2004

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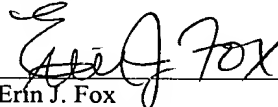
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APPEAL BRIEF

Mail Stop Appeal Brief-Patent
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This appeal is filed in response to the Office action dated February 24, 2004.

(1) Real party in interest

This appeal is made on behalf of S.C. Johnson Home Storage, Inc.

(2) Related appeals and interferences

At present, there are no other appeals or interferences known to appellant, the appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision on the pending appeal.

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(3) Status of claims

Claims 1–86 are pending in the present application. Claims 1–36 are at issue inasmuch as claims 37–86 have been withdrawn.

(4) Status of amendments

No amendments have been filed subsequent to the final rejection.

(5) Summary of invention

The present application claims a method of producing plastic bags wherein the method includes the step of folding a web of plastic to form an elongate folded web having free ends (page 4, lines 10–13). Closer tape is secured to the free ends of the elongate folded web, thereby forming end stops in the closer tape at spaced locations thereof (page 4, lines 14–26). This step includes the step of creating an indicia in each of the end stops, wherein the indicia designates at least one of a production line that produced the plastic bags and a time at which the bags were produced (page 7, lines 14–19). Simultaneously, the elongate folded web is severed and sealed at each of the spaced locations to produce individual bags (page 7, lines 23–28).

Further, the present application claims a method of producing a plastic bag, the method comprising the steps of folding a web of plastic to form an elongate folded web having free ends, securing closer tape to the free ends of the elongate folded web, and forming first and second end stops in the closer tape at spaced locations thereof (page 4, lines 10–26). This step includes the steps of welding portions of at least one of the closer tape and the folded web together at first and second areas adjacent the first and second end stops,

respectively (page 7, line 23 – page 8, line 2). An indicia is created in at least one of the first and second areas and the first and second end stops wherein the indicia designates at least one of a production line that produced the plastic bags and a time at which the bags were produced (page 7, lines 14–19). Simultaneously, the elongate folded web is severed and sealed at each of the spaced locations to produce a bag (page 7, lines 23–28).

(6) Issues

1. Are the claims at issue obvious over Thieman, U.S. Patent 5,956,924?
2. Is the test for patentability of apparatus claims as recited in *In re Gulack*, 703 F.2d 1381 (Fed. Cir. 1983) properly applied to claims reciting methods of production?
3. If a functional relationship is necessary in the case of method claims, does the formation of indicia in the product indicating the production line and/or when the product was made create the functional relationship?

(7) Grouping of claims

Appellant makes no contention that the claims of the group do not stand or fall together.

(8) Argument

Applicant traverses the examiner's rejection of the claims at issue as obvious over Thieman, U.S. Patent No. 5,956,924. Thieman discloses a plastic bag having a fastener profile along a top edge of the plastic bag. The fastener profile has interlocking strips sealed at both ends by end stops. According to Fig. 1 of the disclosure, the end stops appear to have a pattern or texture. The examiner argues that the pattern or texture is indicia and that it

would have been obvious to one having ordinary skill in the art at the time the invention was made to show production line information. Applicant respectfully disagrees with this assertion. The word “indicia” is defined by Webster’s Third New International Dictionary as “a distinctive mark that indicates or that is felt to indicate the nature or quality or existence or reality of something.” Webster’s Third New International Dictionary, 1150 (3d ed. 2002). Thieman discloses a pattern on the end stops that is no more distinctive than any other feature of the bag. In this regard, the Thieman patent discloses:

A portion of this interlocked length of strips 32 and 34 is presented between sealing horn 120 and sealing plate 122. A pneumatic cylinder places horn 120 at a second location along fastener strips 32 and 34 and free ends 107a and 107b, and against sealing plate 122. By means of heat, ultrasonic energy, or similar process horn 120 fuses the portions of fastener strips and sidewall between horn 120 and sealing plate 122 and simultaneously forms a corner seal 40 and endstop 36 of a first container 20, and a corner seal 42 and endstop 38 of an adjacent, second container 20. It is preferable that horn 120 and sealing plate 122 not alter shoulders 45 and 47, such that there remains shoulders 45 and 47 generally across the width of container 20 to restrain slider 48.

As the assembly of web 102, fastener strips 32 and 34, and slider 48 move down along filling tube 104, there is a second repositioning of slider 48. Slider 48 is positioned adjacent the second location fused by horn 120 and sealing plate 122 by positioning arm 124 which holds slider 48 stationary against slider receiver 126, in a manner similar to the positioning by arm 116 and receiver 118. It is preferable, but not necessary, that slider 48 be moved in a manner which interlocks strips 32 and 34 and positioned adjacent endstop 36 before endstop 36 is fully hardened. The softened area of strips 32 and 34 adjacent endstop 36 is thereby permanently deformed by slider 48. This movement of slider 48 into the previously fused area has been observed to reduce leakage from container 20. This permanently deformed area is docking station 39.

...

Sliders 48 are placed along fastener strips 32 and 34 by machine 114 in a manner previously described. Sliders 48 are positioned by arm 116 and receiver 118, a fused spot is created by horn 120 and sealing plate 122, and slider 48 is repositioned by arm 124 and receiver 126, all in a manner as previously described. (Column 5, line 44 – column 6, line 50).

From the foregoing, it is evident that the purpose of the end stops is to restrain the slider on the bag and to provide leak-resistance. There is no express or implied teaching that the pattern of the end stops provides a sensible indication of anything.

The claims at issue recite indicia that “designates at least one of a production line that produced the plastic bags and a time at which the bags were produced.” There is no disclosure or suggestion in Thieman that it would be desirable or even possible to dispose indicia on an end stop of a plastic bag wherein the indicia indicates or identifies the production line that produced the plastic bag. The prior art must disclose at least a suggestion of an incentive for the claimed combination of elements in order for a prima facie case of obviousness to be established. See *In re Sernaker*, 217 U.S.P.Q. 1 (Fed. Cir. 1983) and *Ex Parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. 1985). Accordingly, the obviousness rejection should be withdrawn.

Further, it is applicant’s contention that the test for patentability for apparatus claims is erroneously being applied to the method claims of the application at issue. Each of the cases cited by the examiner, specifically *In re Gulack*, 703 F.2d 1381 (Fed. Cir. 1983); *Application of Miller*, 418 F.2d 1392 (C.C.P.A. 1969); and *Ex parte Brick*, No. 2000-1794, 2001 WL 1738852 (Bd. Pat. App. May 15, 2001) involve applications for patent claiming an apparatus having an element that included printed matter. The application at issue recites methods of producing plastic bags, wherein each method includes the step of creating an indicia. It is applicant’s contention that the new and unobvious functional relationship requirement necessary for apparatus claims is irrelevant to the question of patentability of method claims. The proper test is whether the method, not an apparatus, is unobvious. It is

well accepted that a method claim may be patentable if an otherwise conventional method uses either a novel structural element or a known structural element provided that such use in the claimed method would not have been obvious to a person having ordinary skill in the art. In the present case, the cited prior art does not disclose or suggest the method as claimed in the instant application, and hence the rejection of the claims at issue should be reversed

In any event, the rejection should be reversed because a new and unobvious functional relationship exists between the indicia and the plastic bag. Printed matter alone cannot impart a patentable feature to a claim. *Gulack*, 703 F.2d at 1384. However, “[t]he fact that printed matter by itself is not patentable subject matter, because non-statutory, is no reason for ignoring it when the claim is directed to a combination.” *Miller*, 418 F.2d at 1396. In addition, when the differences between an invention and the prior art include the content of the printed matter, those differences must not be ignored. *Gulack*, 703 F.2d at 1385.

In *Miller* the disclosed invention addressed the domestic culinary problem of measuring out a fractional recipe. *Miller*, 418 F.2d at 1393. The invention was an article of manufacture, in the shape of a measuring receptacle. *Id.* The second element of each claim states, “quantity measuring indicia on the receptacle of a selected ratio or proportion to, but different from the actual quantity measured in the receptacle by the indicia.” *Id.* at 1394. The examiner, who was later affirmed by the Patent Office Board of Appeals and Interferences, argued that for claims 10–13, “the combination of a measuring vessel having printed thereon (1) indicia specifying a given volume and (2) a legend specifying the ratio of this given volume to the actual volume that the vessel is capable of holding, are rejected as defining over any ordinary measuring vessel only by the addition of unpatentable printed

matter.” *Id.* at 1395. On appeal, the Court of Customs and Patent Appeals found that there was a new and unobvious functional relationship between a measuring receptacle, volumetric indicia thereon indicating volume in a certain ratio to actual volume, and a legend indicating the ratio. Accordingly, the decisions of both the Board of Patent Appeals and Interferences and the Examiner were reversed. *Id.* at 1396.

Both *Miller* and the instant application disclose indicia on the article specifying distinctive information relative to the article. In *Miller*, the indicia had a new and unobvious functional relationship to the measuring receptacle. Similarly, in the instant application, the indicia provide a new and unobvious functional relationship between a plastic bag and the production line and/or the time at which the bag was produced.

In re Gulack is also instructive. In *Gulack*, claim 1, directed to an article of manufacture, stated:

An educational and recreational mathematical device comprising at least one band which is endless or adapted to have ends thereof fastened to form an endless band and a plurality of individual digits imprinted on the band at regularly spaced intervals, the digits when all read consecutively clockwise as a number constituting a quotient obtained by dividing a number constituted of $P-1/n$ nines, in which P is a prime number greater than 5 and n is an integer at least 1, by P and adding to the lefthand end of said quotient any number of zeros necessary to increase the number of digits in said quotient to $P-1/n$, n being so selected that $P-1/n$ nines is the minimum number of nines divisible by P so that said quotient is an integral [sic] number.

Gulack, 703 F.2d at 1383–84.

Gulack distinguished *Miller* stating that a functional relationship between the printed matter and the size or type of substrate, or conveying information about the substrate is not necessarily required. *Id.* at 1386. Rather, the critical question is “whether there exists any new or unobvious functional relationship between the printed matter and the substrate.” *Id.*

In addition, when the differences between an invention and the prior art include the content of the printed matter, those differences must not be ignored. *Id.* at 1385.

The examiner originally rejected the claims of Gulack's application as obvious in view of Wittcoff. *Id.* at 1384. The difference between the appealed claims and Wittcoff was the particular sequence of digits and the derivation of that sequence of digits. *Id.* The *Gulack* court found that there was no disclosure or suggestion in the cited reference of appellant's particular sequence or of the derivation of that sequence and therefore reversed the examiner's and the Board of Patent Appeals and Interferences' holdings. *Id.* at 1386–87.

Another similar case, *Ex parte Brick*, had at issue an invention that included a wrapping material for covering an article, an elongated tape partially hidden beneath the wrapping material, and a visible gripping portion disposed externally of the wrapped article to assist in removal of the wrapping material. *Brick*, 2001 WL 1738852, at *1. In the package assembly, "the visible gripping portion of the elongated tape [has] a first message associated therewith and the hidden portion of the elongated tape [has] a second message associated therewith intellectually compatible with the first message which becomes available for viewing upon unwrapping the wrapping material from the article." *Id.* The examiner contended that it would have been obvious to one skilled in the art to add these functions to the tape of a Hershey's Kisses chocolate candy. *Id.* at *3. The Board of Patent Appeals and Interferences, however, found that the claims recited a specific functional relationship between the solicitive first message and the responsive second message and the tape (substrate) and therefore reversed the examiner's obviousness rejection asserting it was "completely devoid of factual support." *Id.* at *4.

A recent case, *In re John Ngai*, was decided by the Court of Appeals for the Federal Circuit on March 8, 2004, and related to an invention claiming the addition of a new set of instructions into a known kit for normalizing and amplifying an RNA population. *In re John Ngai*, No. 03-1524, 2004 U.S. App. LEXIS 4372, at *2 (Fed. Cir. March 8, 2004). The court held that the only function of the printed matter (instructions) was to teach a new use for an existing product and therefore, because there was no functional relationship to the substrate, the printed matter did not distinguish the invention from the prior art in terms of patentability. *Id.* at *6. In upholding the Board of Patent Appeals and Interferences' decision, the court said that "[i]f we adopt Ngai's position, anyone could continue patenting a product indefinitely provided that they add a new instruction sheet to the product." *Id.* Unlike *Ngai*, the present application claims a method of producing plastic bags wherein the step of creating an indicia leads to a desirable and useful end result.

In summary, the claims at issue are not obvious over the Thieman reference. Further, the rejection should be reversed because the test for patentability for an apparatus claim is erroneously being applied to the method claims of this application. In addition, the rejection should be reversed because a new and unobvious functional relationship exists between the indicia and the plastic bag.

Reconsideration and allowance of the claims at issue are respectfully requested.

Respectfully submitted,

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July 26, 2004

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